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EXAMINER

MURPHY, DILLON J

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

- This action is responsive to the amendment filed on February 1, 2006.
- Claims 1-25 are pending. Claims 1, 11, and 18 have been amended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by
Czyszczewski et al. (US 6,577,907), hereafter referred to as Czyszczewski.

Regarding claim 18, Czyszczewski teaches a multifunction device (figure 1, #10) comprising computer-readable media operatively associated with said multifunction device and having computer-readable program code thereon including program code (figure 1, multifunction controller comprises CPU (figure 2, #80), RAM, (figure 2, #85) and ROM (figure 2, #90). ROM of figure 2 comprises a controller operating system #95 as well as a document processing pipeline #100) for identifying different types of network destinations to receive a document (col 6, ln 62-67, when new devices are added to the network, a global database is updated, identifying available network destinations on the network), program code for automatically determining format for said

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document (Czyszczewski, col 8, ln 61-64, automatic formatting for printer, depending on property of network destination. ASCII data is automatically formatted into PostScript if the destination specified is a printer), program code for automatically determining at least one document property (Czyszczewski, fig 9d, and col 7, ln 48-54, wherein upon selecting a format, formatting inherently automatically determines and configures a document property. Formatting was selected for a network destination, formatting includes but is not limited to automatically configuring a document property, therefore property configuring is based on a network destination) for optimizing output at each of said different types of network destinations (Czyszczewski, fig 9D, wherein document properties in PDF format are optimized for viewing and printing, and wherein document properties in text format are optimized for importing a document into a word processor for editing), program code for formatting said document for each of said different types of network destinations (col 7, ln 12-19, one scanning operation is required to allow a user to send a document to each of the different types of network devices including local printers, network printers, fax machines, or e-mail addresses. Formatting occurs once to process document for each destination, col 7, ln 48-54), and program code for sending said formatted document from said multifunction device to each of said different types of network destinations (col 7, ln 19-22, document is sent to selected network destinations), wherein said document is imaged only once for delivery to each of said different types of network destinations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-7, 11-14, and 19-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski et al. (US 6,577,907) in view of Quine (US 6782415), hereafter referred to as Czyszczewski and Quine.

Regarding claim 1, Czyszczewski teaches a document delivery method comprising: identifying different types of network destinations for receiving a document (col 6, ln 62-67, when new devices are added to the network, a global database is updated, identifying available network destinations on the network); formatting said document for each of said different types of network destinations without re-imaging said document (col 7, ln 12-19, one scanning operation allows a user to send a document to different types of network devices including local printers, network printers, fax machines, or e-mail addresses. Formatting occurs to process document for each destination, col 7, ln 48-54); automatically configuring at least one property of said document based on said different types of network destinations (Czyszczewski, fig 9d, and col 7, ln 48-54, wherein upon selecting a format, formatting inherently automatically configures a document property. Formatting was selected for a network destination, formatting includes but is not limited to automatically configuring a document property, therefore property configuring is based on a network destination) for optimizing output of

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said document at said different types of network destinations (Czyszczewski, fig 9D, wherein document properties in PDF format are optimized for viewing and printing, and wherein document properties in text format are optimized for importing a document into a word processor for editing); and sending said formatted document to each of said different types of network destinations from a multifunction device (col 7, ln 19-22, document is sent to selected network destinations). Czyszczewski does not teach a method of receiving a document based on a preferred mode of receipt by the recipient. Quine, however, teaches a method for document delivery comprising receiving a document based on a preferred mode of receipt by the recipient (Quine, col 4, ln 47-67, wherein delivery preferences are stored for each user and documents are delivered according to recipient preferences). Additionally, Quine teaches a method of automatically configuring document properties based on a network destination for optimizing output of the document at the network destination (Quine, col 4, ln 47-51, wherein in a database system, user preferences regarding the preferred mode of communication and the preferred format are defined for each user. See col 5, ln 8-32, wherein formats and corresponding document properties are automatically configured for optimizing output of a document for different types of network destinations).

Czyszczewski and Quine are combinable because they are from a similar field of endeavor of document delivery systems and method. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the document delivery method of Quine comprising identifying network destinations based on a preferred mode of receipt by the recipient with the document delivery method of

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Czyszczewski comprising identifying, formatting, and sending a document to a recipient. The motivation for doing so would have been to improve delivery speed, accuracy, and effectiveness of the document delivery (Quine, col 7, ln 65-67, col 8, ln 1-14), as well as to provide an improved architecture and user interface for a multifunction device, (Czyszczewski, col 1, ln 34-36). Therefore, it would have been obvious to combine Quine with Czyszczewski to obtain the invention as specified in claim 1.

Regarding claim 2, which depends from claim 1, the combination of Czyszczewski and Quine teaches a method wherein sending said formatted document to each of said different types of network destinations is via serial transmission (col 5, ln 64-67 and col 6, ln 1-2, output devices are connected via LAN, which is by definition a serial transmission network, wherein formatted documents are sent over the LAN).

Regarding claim 3, which depends from claim 1, the combination of Czyszczewski and Quine teaches a method further comprising converting said document to electronic format, wherein said electronic document is formatted and sent (col 26-32, documents can be held in memory of controller until a print request is issued, for example. Controller comprises RAM (col 6, ln 8-15), therefore, document must be in electronic format to be stored).

Regarding claim 4, which depends from claim 1, the combination of Czyszczewski and Quine teaches a method wherein identifying said different types of network destinations is based at least in part on a user selection (col 7, ln 16-17, user selects a destination or destinations for a document).

Regarding claim 5, which depends from claim 1, the combination of Czyszczewski and Quine teaches a method wherein identifying said different types of network destinations is based at least in part on a user-sorted type of network destination (Czyszczewski, col 11, ln 18-27, when identifying a particular destination, user may limit identification by entering name of recipient to limit available network destinations. See also Czyszczewski, col 11, ln 33-45, wherein the user is not limited to sending a job to either a facsimile destination or electronic mail destination, but may choose a plurality of destinations for a document. Also see Quine, col 2, ln 59-65, wherein a user may sort destinations by desired parameters, e.g. location or job description).

Regarding claim 6, which depends from claim 1, the combination of Czyszczewski and Quine teaches a method wherein formatting said document is automatically determined based at least in part on a property of the different types of network destinations (Czyszczewski, col 8, ln 61-64, automatic formatting for printer, depending on property of network destination. ASCII data is automatically formatted into PostScript if the destination specified is a printer. Also see Quine, col 4, ln 60-67, wherein method further comprises delivering document to a recipient in a preferred format, wherein documents must be automatically formatted into preferred format).

Regarding claim 7, which depends from claim 1, the combination of Czyszczewski and Quine teaches a method wherein formatting said document is based at least in part on a property of the document (col 8, ln 40-67 and col 9, ln 1-12, example formatting includes steps A-G. Step 'B,' used when operating in an image

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quality mode, may be bypassed when a document does not include high-quality images).

Regarding claim 11, the combination of Czyszczewski and Quine teaches a document delivery method comprising (Czyszczewski and Quine are combined as explained above in claim 1):

Converting a printed document to an electronic document only once with a multifunction device (Czyszczewski, figure 1, multifunction device #10 comprises scanner #20 which scans in documents. In col 26-32, documents can be held in memory of controller until a print request is issued, for example. Controller comprises RAM (col 6, ln 8-15), therefore, document must be in electronic format to be stored);

Identifying preferred network destinations for each of a plurality of recipients to receive said electronic document (Czyszczewski, col 6, ln 62-67, when new devices are added to the network, a global database is updated, identifying available network destinations on the network. Plurality of recipients is taught in col 7, ln 19-25 of Czyszczewski. See also Quine, col 4, ln 47-67, wherein network destinations are identified and stored for each user and documents are delivered according to recipient preferences);

Formatting said document for different types of said preferred network destinations (Czyszczewski, col 7, ln 12-19, one scanning operation allows a user to send a document to different types of network devices including local printers, network printers, fax machines, or e-mail addresses. Formatting occurs to process document for

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each destination, col 7, ln 48-54. Preferred network devices are taught by Quine as explained above);

Automatically configuring at least one property of said document based on said different types of network destinations (Czyszczewski, fig 9d, and col 7, ln 48-54, wherein upon selecting a format, formatting inherently automatically configures a document property. Formatting was selected for a network destination, formatting includes but is not limited to automatically configuring a document property, therefore property configuring is based on a network destination) for optimizing output of said document at said different types of network destinations (Czyszczewski, fig 9D, wherein document properties in PDF format are optimized for viewing and printing, and wherein document properties in text format are optimized for importing a document into a word processor for editing. Also see Quine, col 4, ln 47-51, wherein in a database system, user preferences regarding the preferred mode of communication and the preferred format are defined for each user. See col 5, ln 8-32, wherein formats and corresponding document properties are automatically configured for optimizing output of a document for different types of network destinations); and

Sending said formatted electronic document from said multifunction device to each of said plurality of recipients (Czyszczewski, col 7, ln 19-22, document is sent to selected network destinations).

Regarding claim 12, which depends from claim 11, the combination of Czyszczewski and Quine teaches a method wherein sending said formatted document to each of said different types of network destinations is via serial transmission (col 5, ln

64-67 and col 6, ln 1-2, output devices are connected via LAN, which is by definition a serial transmission network, wherein formatted documents are sent over the LAN).

Regarding claim 13, which depends from claim 11, the combination of Czyszczewski and Quine teaches a method wherein identifying said different types of network destinations is based at least in part on a user-identified limitation (Czyszczewski, col 11, ln 18-27, when identifying a particular destination, user may limit identification by entering name of recipient to limit available network destinations. See also Czyszczewski, col 11, ln 33-45, wherein the user is not limited to sending a job to either a facsimile destination or electronic mail destination, but may choose a plurality of destinations for a document. Also see Quine, col 2, ln 59-65, wherein a user may sort destinations by desired parameters, e.g. location or job description).

Regarding claim 14, which depends from claim 11, the combination of Czyszczewski and Quine teaches a method wherein formatting said electronic document is based at least in part on the type of said network destination (Czyszczewski, col 8, ln 61-64, automatic formatting for printer, depending on property of network destination. ASCII data is automatically formatted into PostScript if the destination specified is a printer. Also see Quine, col 4, ln 60-67, wherein method further comprises delivering document to a recipient in a preferred format, wherein documents must be automatically formatted into preferred format).

Regarding claim 19, which depends from claim 18, the combination of Czyszczewski and Quine teaches a multifunction device further comprising an interface for receiving at least one user selection (col 6, ln 18-20, touch screen provides the

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Graphical User Interface (GUI) to the user of the multifunction device), wherein said program code for identifying said different types of network destinations bases said identification at least in part on said at least one user selection (col 7, ln 16-17, user selects a destination or destinations for a document) and at least in part on a recipient preference for receiving said document (Quine, col 4, ln 47-67, wherein delivery preferences are stored for each user and destinations are identified and documents are delivered according to recipient preferences).

Regarding claim 20, which depends from claim 19, the combination of Czyszczewski and Quine teaches a multifunction device wherein said computer-readable program code comprises program code for sorting said different types of network destinations based on said at least one user selection (Czyszczewski, col 11, ln 18-27, when identifying a particular destination, user may limit identification by entering name of recipient to limit available network destinations. See also Czyszczewski, col 11, ln 33-45, wherein the user is not limited to sending a job to either a facsimile destination or electronic mail destination, but may choose a plurality of destinations for a document. Also see Quine, col 2, ln 59-65, wherein a user may sort destinations by desired parameters, e.g. location or job description)

Regarding claim 21, which depends from claim 18, the combination of Czyszczewski and Quine teaches a multifunction device further comprising a computer-readable address book for identifying said different types of preferred network destinations (Czyszczewski, col 11, ln 66-67 and col 12 ln 1-23, user may browse through address book to identify fax numbers, e-mail addresses, phone numbers, and

the like of, a network destination. See also Quine, col 4, ln 47-67, wherein delivery preferences are stored for each user and destinations are identified and documents are delivered according to recipient preferences).

Regarding claim 22, which depends from claim 18, the combination of Czyszczewski and Quine teaches a multifunction device wherein said computer-readable program code comprises program code for configuring a property of said document for each of said different types of network destinations (col 8, ln 5-7, drivers for formatting document are adapted for different network destinations, also col 8, ln 12-15, instead of Postscript formatting for a printer, document may be converted into a PDF which is sent as e-mail).

Regarding claim 23, which depends from claim 18, the combination of Czyszczewski and Quine teaches a multifunction device further comprising program code for converting said document to electronic format (col 26-32, documents can be held in memory of controller until a print request is issued, for example. Controller comprises RAM (col 6, ln 8-15), therefore, document must be in electronic format to be stored).

Claims 8-10, 15-17, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski et al. (US 6,577,907) in view of Quine (US 6,782,415) in further view of Daniels, Jr. et al. (US 6,343,327), hereafter referred to as Czyszczewski, Quine, and Daniels.

Regarding claim 8, which depends from claim 1, the combination of Czyszczewski and Quine teaches a document delivery method comprising identifying

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different types of network destinations based on preferred mode of receipt by the recipient, formatting a document for different types of network destinations without re-imaging said document, automatically configuring document properties for a network destination to optimize the output of the document at the network destination, and sending said formatted document to each of the different network destinations, as explained in the rejection of claim 1 above. The combination of Czyszczewski and Quine does not disclose expressly a method further comprising resending said document to a next preferred network destination for the same recipient upon a predetermined condition being satisfied. Daniels, however, discloses a method of resending said document to a next preferred network destination for the same recipient upon a predetermined condition being satisfied (Daniels, col 7, ln 17-21, wherein document is resent to a next preferred network destination for the same recipient. A resending predetermined condition is shown in col 7, ln 9-15 of Daniels).

Czyszczewski, Quine, and Daniels are combinable because they are from the same field of endeavor of document delivery methods. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of resending to a next preferred network destination for the same recipient based upon a predetermined condition method of Daniels with the identifying, formatting, and sending method of the combination of Czyszczewski and Quine. The motivation for doing so would have been to improve delivery speed, accuracy, and effectiveness of the document delivery (Quine, col 7, ln 65-67, col 8, ln 1-14). Therefore, it would have been

obvious to combine Daniels with the aforementioned combination of Czyszczewski and Quine to obtain the invention as specified in claim 8.

Regarding claim 9, which depends from claim 8, the combination of Czyszczewski, Quine, and Daniels further teaches a method wherein said predetermined condition is satisfied when said document is undeliverable to said at least one of said different types of network destinations (Daniels, col 7, ln 9-16, wherein predetermined condition is notification or realization of a delivery failure. See also Daniels, col 2, ln 20-23, showing that a predetermined condition is a notification or realization of a delivery failure).

Regarding claim 10, which depends from claim 8, the combination of Czyszczewski, Quine, and Daniels further teaches a method wherein resending said document is according to a user-selected cycle function (Daniels, col 7, ln 17-21, wherein resending is according to a user-selected cycle function, i.e. resending occurs in accordance with preferred delivery destinations selected by user when inputting preferences. See also col 6, ln 65-67, and col 7, ln 1-4, wherein delivery information is specified in a data file, with options specified and selected previously by user).

Regarding claim 15, which depends from claim 11, the combination of Czyszczewski, Quine, and Daniels further teaches a method further comprising resending said electronic document to the same recipient at another preferred network destination upon a predetermined condition being satisfied (Daniels, col 7, ln 17-21, wherein document is resent to a next preferred network destination for the same recipient. A resending predetermined condition is shown in col 7, ln 9-15 of Daniels).

Regarding claim 16, which depends from claim 15, the combination of Czyszczewski, Quine, and Daniels further teaches a method further comprising satisfying said predetermined condition when said electronic document is undeliverable to said at least one of said different types of network destinations (Daniels, col 7, In 9-16, wherein predetermined condition is notification or realization of a delivery failure. See also Daniels, col 2, In 20-23, showing that a predetermined condition is a notification or realization of a delivery failure).

Regarding claim 17, which depends from claim 15, the combination of Czyszczewski, Quine, and Daniels further teaches a method wherein resending said electronic document is in response to a user-selected cycle function (Daniels, col 7, In 17-21, wherein resending is according to a user-selected cycle function, i.e. resending occurs in accordance with preferred delivery destinations selected by user when inputting preferences. See also col 6, In 65-67, and col 7, In 1-4, wherein delivery information is specified in a data file, with options specified and selected previously by user).

Regarding claim 24, which depends from claim 18, the combination of Czyszczewski, Quine, and Daniels further teaches a multifunction device wherein said computer-readable program code comprises program code for resending said document to a same recipient at an alternate network destination upon a predetermined condition being satisfied (Daniels, col 7, In 17-21, wherein document is resent to a next preferred network destination for the same recipient. A resending predetermined condition is shown in col 7, In 9-15 of Daniels).

Regarding claim 25, which depends from claim 18, the combination of Czyszczewski, Quine, and Daniels further teaches a multifunction device wherein said predetermined condition is satisfied when said document is undeliverable to said at least one of said different types of network destinations (Daniels, col 7, ln 9-16, wherein predetermined condition is notification or realization of a delivery failure. See also Daniels, col 2, ln 20-23, showing that a predetermined condition is a notification or realization of a delivery failure).

Response to Arguments

Applicant's arguments filed February 1, 2006 have been fully considered but they are not persuasive.

Applicants argue, on page 8, line 18-page 9, line 4, that Czyszczewski teaches the user selecting a format for a document, e.g. between PDF or text format, while claiming Czyszczewski selecting a document implies manually selecting a document property. However, upon selecting a document format, the processing inherently automatically configures at least one document property relating to the specific format.

Additionally, as per the Applicant's argument that there is no suggestion or teaching in Czyszczewski of a automatically determining a format for a document (Page 8 of Remarks filed February 1, 2006), the Examiner contests based on the mere fact that because the processing automatic, that is not enough to distinguish it from the prior art. See MPEP 2144.04. See also In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). The court held that broadly providing an automatic or mechanical means

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to replace a manual activity, which accomplished the same result, is not sufficient to distinguish over the prior art.

Regarding automatically configuring at least one property of a document based on a different types of network destinations for optimizing output at each type of network destination, see Quine, col 4, ln 47-51, wherein in a database system, user preferences regarding the preferred mode of communication and the preferred format are defined for each user. See col 5, ln 8-32, wherein formats and corresponding document properties are automatically configured for optimizing output of a document for different types of network destinations. Also see Czyszczewski in figure 9D, wherein PDF is a format wherein document properties are optimized for viewing and printing, and wherein text format comprises document properties optimized for importing into a word processor for editing.

Applicant argues, on page 9, line 23-page 10, line 8, that the citation in Czyszczewski at col 8, ln 5-7 is impermissible to teach both document formatting and configuring a document property. Document formatting is a broad process that includes, but is not limited to, configuring document properties. By formatting a document into a particular format, properties within the document are inherently and automatically configured according to the format. Also see col 11, ln 45-57 of Czyszczewski, wherein additional document properties may be manually configured or be applied as a default, i.e. automatically.

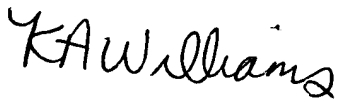
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM


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